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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,647	07/09/2003	Martin M. Bolnick	1099/28	9304

7590 04/07/2005

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One Broadway
New York, NY 10004

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,647

Applicant(s)

BOLNICK ET AL.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/9/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. In line 3 of each of independent claims 1 and 13, the phrase "self-adhering adhesive" is more conventionally known as either --self-adhesive-- or --pressure sensitive adhesive-- and it is suggested that the claims be amended accordingly.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bolnick et al. -735. The reference discloses an example of the two co-inventors' earlier work, wherein a multi-segment label form which includes an elongated label carrying sheet, a plurality of adjacent label forms, a first and second label segment, a mounting sheet and a detachment means such as perforations, notches and slit lines are clearly disclosed (e.g. claims 1,7). Additionally, with respect to the dependent claims, such parameters as removable covers, a non-stick silicone surface and a transparent polyester mounting

sheet are also disclosed. The independent claims differ primarily with respect to the fact that the mounting sheet is disclosed in the reference as having a "temporary affixation adhesion layer" on the second major surface, whereas applicants claim a permanent affixation adhesive layer on the second major surfaces of the first and second mounting sheet segments. However, as was set forth in the parent application, Serial No. 09/484,701, the presence of a "duplication of parts" is believed to be patentably insignificant in the absence of any new and unexpected results which the Examiner believes have yet to be shown on the record. Additionally, with respect to applicants' remarks in the parent case regarding the alleged patentably significant differences between the permanent or temporary bond formed such as set forth in Figure 8 of the reference versus that disclosed in the pending application, the Examiner must respectfully disagree. It is believed that the temporary adhesive of the reference can be a permanent adhesive or any other type of adhesive having various degrees of tack, cohesiveness and the like, absent any evidence to the contrary, since it is believed that such levels of adhesiveness are relative and optimizable, i.e. they are parameters whose manipulation to produce a desired adhesive level is well within the ordinary skill of the art. Bolnick et al. also discloses in

Figure 8 a permanent adhesive layer 55 which is coated on the second major surface 54, thereby negating applicants' earlier referred to argument. Additionally, note that in the embodiment in Figure 12 of the invention a "detachable" layer of adhesive 215 which is not a permanent adhesive is disclosed in a substantially similar embodiment to that of Figure 8. Finally, with respect to applicants' remarks presented in the parent application note that that invention provides a protective cover over the first major surface -205 of the first label segment 203 and thereby involves a limitation that is not set forth in the independent claims. Other parameters that are not either expressly or inherently disclosed are each believed to be at most obvious optimizations to one of ordinary skill, in the absence of unexpected results.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

April 4, 2005

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900

1700

Daniel Zinker